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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,316	07/26/2001	Stuart Corr	P 281549 CHAP2/50746/US	4954

909 7590 10/29/2002

PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No. 09/912,316	Applicant(s) CORR ET AL	
Office Action Summary	Examiner Ellen M McAvoy	Art Unit 1764	YB

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. | 6) <input type="checkbox"/> Other: |

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Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112/101

Claim 16 provides for the use of "a refrigeration lubricant as defined in claim 1", but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 16 is also rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, the phrase "as defined in any one of the preceding claims" is indefinite; the phrase should be amended to "as defined in claims 1-14".

In claim 10, the parenthical phrase "(linear or branched)" is indefinite.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-5, 7-9 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glova (4,556,496).

Glova discloses a refrigeration lubricating oil composition comprising (A) a branched-chain alkylbenzene or mixture of branched-chain alkylbenzenes as a base oil and (B) about 50 ppm to 5 weight percent of a dialkyl sulfosuccinate having the formula set forth in column 1, lines 40-44, which acts to promote foaming in the oil thus effectively decreasing the noise level of compressors lubricated with the alkylbenzenes. Applicants' teach in the specification on page 9 that suitable base oils for the inventive lubricant composition include alkylbenzene oils. The examiner is of the position that the refrigerant lubricant of Glova clearly meets the limitations of the above rejected claims when the lubricant is an alkylbenzene synthetic oil and when the amphiphilic anti-deposition component is an alkyl sulphosuccinate. Although the property of anti-deposition for the sulfosuccinate component is not taught by Glova, the property is seen to be inherent, i.e., the property was always present but went unrecognized. Discovery of inherent properties of known compositions, while beneficial, cannot render the patentability of a known composition and a known method of using the composition.

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Claims 1, 2, 4-6, 8-9, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes-Gavilan et al (5,792,383).

Reyes-Gavilan et al ["Reyes-Gavilan"] disclose fluid refrigeration compositions comprising a hydrocarbon lubricant such as alkylbenzene oils; an immiscible refrigerant such as chlorofluorocarbons, R-134a (1,1,1,2-tetrafluoroethane), and mixtures thereof; and an additive or surfactant capable of reducing the interfacial tension between the hydrocarbon lubricant and the refrigerant such as fluorocarbon esters sold as FC-430. See column 3, line 60 to column 4, line 46. The fluorocarbon ester component of the invention may also be FC-430 as set forth in the specification on page 21. The additive can be used in the range of 0.001 to 5 parts by weight per 100 parts by weight lubricating oil. See column 5, lines 22-32. The examiner is of the position that the refrigerant composition of Reyes-Gavilan meets the limitations of the above rejected claims when the amphiphilic anti-deposition component is a fluorocarbon ester.

Claims 1-5, 7-9 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magid et al (4,755,316).

Magid et al ["Magid"] disclose a composition for use in compression refrigeration comprising tetrafluoroethylene as a refrigerant and at least one polyoxyalkylene glycol as the lubricating oil. See column 3, lines 33-55. Magid allows for the addition of additives which may be used to enhance the performance of the polyglycol lubricant including extreme pressure and antiwear agents and detergents. Suitable detergents include sulfonates and long-chain alkyl substituted aromatic sulfonic acids. See column 9, line 55 to column 10, line 63. The examiner

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is of the position that the compositions of Magid clearly meet the limitations of the above rejected claims when the lubricant is a polyalkylene glycol and the anti-deposition agent is a sulfonate or an aromatic sulfonic acid.

Claims 1-5, 7-11, 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schnur et al (5,906,769).

Schnur et al ["Schnur"] disclose a high quality lubricant for heavy duty service air conditioner and refrigerator compressors, especially those using mixtures of chlorine free hydrofluorocarbon refrigerant working fluids, which comprises mixed esters of hindered polyols such as pentaerythritol and dipentaerythritol, with a mixture of carboxylic acids. See column 2, line 18 to column 3, line 13, and the claims. Schnur teaches that the ester lubricants may contain conventional additives such as oxidation resistance and thermal stability improvers, corrosion inhibitors, detergents and dispersants. See column 5, lines 50-65. Examples of suitable detergents and/or dispersants include phosphonic acid derivatives and long-chain alkyl substituted aromatic sulfonic acids and their salts. See column 6, line 64 to column 7, line 20. The examiner is of the position that the compositions of Schnur clearly meet the limitations of the above rejected claims when the lubricant is a polyol ester and the anti-deposition agent is an aromatic sulfonic acid compound.

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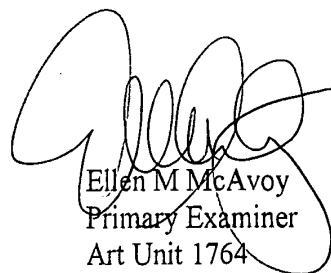
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
October 25, 2002